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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,272	07/19/2001	Emil Willi Reppel	34513-072432.0164	2184
21003	7590	10/10/2003	EXAMINER	
BAKER & BOTTS 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			KNABLE, GEOFFREY L	
		ART UNIT		PAPER NUMBER
		1733		

DATE MAILED: 10/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	09/909,272	Applicant(s)	REPPEL, EMIL WILLI
Examiner	Geoffrey L. Knable	Art Unit	1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 18 July 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-9 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-9 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____.

2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) Other: _____

1. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The new last 5 lines of claim 1 are considered for several reasons to add material which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e. they are considered to add new matter. In particular, first, it is not considered that the original disclosure describes that the recapping tools are able to "contact substantially an entire exterior of the tire". While there is original description (in the third to last paragraph of the specification) that the rasping tools can contact any point on the surface of the tread, shoulder and sidewalls, this is not considered to be synonymous with "substantially an entire exterior of the tire" as now claimed, it being noted particularly that the lower parts of the tire are not generally considered part of the sidewall but rather form part of the bead area and there is no original description that such are contacted. Further, along somewhat similar lines, the above noted paragraph of the specification describes that the *combination* of the two horizontal translations makes the contact possible, not "when at least one of the recapping tools and the mandrel is translated" as now claimed. Such is thus also considered to be new matter. Finally, the description that a "distance between the carriage and a center of mass of the tire remains approximately constant" has no

explicit or implicit basis in the original disclosure and thus likewise is considered to be new matter. While the original disclosure does indicate that the center of gravity of the tire is kept on a single axis parallel to the rotation axis during translation, the original disclosure never describes or indicates that the invention contemplates a distance between the carriage and center of mass remaining approximately constant (it further being noted that the original disclosure does not use the term "center of mass" – while this is often used synonymously with "center of gravity", this is strictly only true in a constant gravity field and it is suggested that the original language be used to avoid any issue in this regard). As just one illustration of why this is not originally described, note for example that as the old tread is buffed off the tire, the center of mass/gravity of the tire is in fact changing position and thus in fact would be changing in "distance" from the carriage, this being contrary to the new claim language. For each of these reasons, therefore, the new language added to the last 5 lines of claim 1 is considered to not be described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e. is considered to introduce new matter.

2. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In addition to the new matter issue detailed above, it is additionally not entirely clear how the newly claimed "distance" is defined or measured. In particular, it is not clear to what part of the carriage this distance is measured or even in what direction this

distance measurement is to be made. As such, the scope of these claims is considered to be indefinite.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-4, 6 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Hawkinson, Jr. (US 3,528,476) or Hawkinson (US 2,965,162) as applied in the last office action.

As to the new requirements of claim 1, it is not entirely clear whether the Hawkinson references provide the claimed capability but it would appear reasonable to expect that the significant and substantial adjustment capability provided in both references in almost every direction would provide a capability to contact all parts of a tire, even if this is not the intended operation. To the extent that this were not deemed an implicit capability, a new ground of rejection will be provided below to address this new claim limitation.

5. Claims 1-4, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkinson, Jr. (US 3,528,476) or Hawkinson (US 2,965,162) as applied above, and further in view of Cahill (US 3,675,706).

As already noted above, it is not unreasonable to consider that the wide adjustment capability provided by the Hawkinson references would provide a movement capability consistent with that claimed. In any event, even if not considered implicit, it is considered that the ordinary artisan would have found it to have been obvious to provide movement capability to be inclusive of a capability to buff the sidewalls in light

of Cahill. In particular, Cahill evidences that it is desirable to provide a buffing machine with the capability to buff not only the crown/shoulder region but also the sidewalls – e.g. note col. 2, lines 18-22. Further, in similar manner to the Hawkinson references (e.g. note oscillation indicated in fig. 5 of Hawkinson '162), this reference provides the buffer with the capability to follow a template and in particular indicates that the provision of an oscillation motion that may oscillate 180 degrees or more provides the capability to treat the sidewalls (e.g. col. 8, lines 67-72). In light of this teaching, it would have been *prima facie* obvious to provide a movement capability in the buffers of the primary references in order to enable buffing not just the crown but also the sidewalls.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as obvious over Hawkinson, Jr. (US 3,528,476) or Hawkinson (US 2,965,162) taken alone or further in view of Cahill (US 3,675,706) as applied above and further in view of the admitted state of the prior art as applied in the last office action.

7. Claims 5, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkinson, Jr. (US 3,528,476) or Hawkinson (US 2,965,162), taken alone or further in view of Cahill (US 3,675,706) as applied above, as well as taken alone or further in view of the admitted state of the prior art as applied above, and further in view of Andersson et al. (US 6,251,204) and/or Marangoni (US 4,036,677) and/or Schmidt (US 2,009,524) as applied in the last office action.

8. Applicant's arguments filed July 18, 2003 have been fully considered but they are not persuasive.

Applicant first urges that the Hawkinson references have a second support structure having recapping tools on a cam structure capable of translating in a direction "parallel" to the mandrel shaft direction. While there may be a movement capability parallel to the shaft, the recapping tools also clearly can be translated perpendicular to the mandrel shaft for reasons detailed in the last office action. It is also argued that the distance between the center of mass and support changes when a larger tire is mounted. It however is noted that it is not seen what in the amended claims defines anything about this distance based upon changing the tire size. Rather, the claims at present define apparently that this distance remains constant with translation movements and it is not seen that the references fails to satisfy this requirement. That is, if the supporting carriages move with the tire, then it would seem that the claimed distance would remain constant with translation.

It is also pointed out by applicant that the Hawkinson references require a cam and cam follower to accomplish recapping. While it is accurate that these references do require a cam/follower arrangement, this is provided to effect the necessary relative rotation of the buffing head relative to the tire so that the blades remain in operative position across the tire and it is submitted that nothing in the present claims in any way exclude such motion capability. In fact, as would seem readily apparent, in applicants invention also, translation movements alone will be incapable of actually positioning the buffing tools in proper orientation relative to the tire as different lateral parts of the tire are accessed. In other words, it would seem that applicant's tools must also undergo a relative rotation, be it using cam/followers or otherwise, to actually bring the buffing tools

into suitable orientation to actually buff the different tire parts. There is thus no inconsistency between the references' providing means to vary the buffing tool orientation during buffing and what is required by the present claims – again, both references provide an ability to translate along the claimed directions, this being considered to either implicitly, or in any event, obviously (esp. in light of newly cited Cahill) provide a capability to reach sidewall portions as well as the crown as claimed.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 703-308-2062. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino be reached on 703-308-3853. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



Geoffrey L. Knable
Primary Examiner
Art Unit 1733

G. Knable
October 3, 2003